

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Office Action dated December 15, 2006. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

Status of the Claims

As outlined above, claims 1-6, 8-17, 19-21 and 23 stand for consideration in this application, wherein claims 7 and 18 were canceled and claim 22 is being canceled without prejudice or disclaimer, while claims 1 and 12 are being amended to correct formal errors and to more particularly point out and distinctly claim the subject invention.

All amendments to the application are fully supported therein. In particularly, support for amendments of claim 1 and 12 may be found on Fig. 21 and page 39, line 15 – page 43, line 10 of the specification. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

Prior Art Rejections

The First 35 U.S.C. §103(a) rejection

Claims 1-6, 8-10, 12-17 and 19 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Summerell et al. (U.S. Pat. 5,937,387) in view of Campell et al. (U.S. Pat. 6,059,724) in further view of Jagger (Jagger, Carol, "Health Expectancy Calculation by the Sullivan Method: A practical Guide" June 13, 2001). Claim 11 was rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Summerell, Campell, and Jagger, as applied to claim 1, and further in view of Joao (U.S. Pat. 6,283,761). Claim 20 was rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Summerell, Campell, and Jagger, as applied to claim 1, and further in view of Iliff (U.S. Pat. 6,569,093) and further in view of Seare et al. (U.S. Pat. 5,557,514). Claims 21-23 was rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Summerell, Campell, in view of Jagger, and further in view of Joao (U.S. Pat. 6,283,761). These rejections are respectfully traversed for the reasons set forth below.

According to the Manual of Patent Examining Procedure (M.P.E.P. §2143),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both not be found in the prior art, not in the applicant's disclosure.

Claim 1

Claim 1 as amended substantially incorporates the elements recited in claim 22, which is being canceled, reciting that preparing medical payment prediction knowledge data as basic data for predicting medical payment from a diversity of healthy life expectancy; and calculating a predicting amount of future medical payment of the each person who undergoes health screening based on the predicted period of healthy life expectancy of the each person and the medical payment prediction knowledge data; wherein a predicting amount of future medical payment is calculated by the summation of the average medical expenses a year per age multiplied by correction coefficients for the predicted duration of disease and/or disability that is difference between an average life expectancy and the predicted period of healthy life expectancy, the correction coefficients being set so as to decrease the average medical expenses a year per age as the recuperation period is prolonged.

As shown in Fig. 21, a graph 73 represents transition of an individual's average medical expense a year. Regardless of a length of a recuperation period, prediction of medical payment per year per age is the same in the graph 73. In general, operation costs are high and long-term treatment costs are low. Operation costs and long-term treatment costs are neglected in calculating the prediction of medical payment using the relationship described in the graph 73. Therefore, for many diseases including lifestyle related diseases which need long-term treatment after an operation, the prediction of medical payment calculated by merely summing annual average medical expenses per age in a certain period becomes lower than actual medical payment where a recuperation period is short, and is higher than actual medical payment where a recuperation period is long.

In contrast, in the method recited in claim 1, the prediction amount of the future medical payment is calculated by multiplying an average medical expense a year per age by a correlation coefficient regarding each age for a recuperation period and summing the

products. Because the correlation coefficients are set so as to decrease the average medical expense per year as the recuperation period is prolonged, as shown in the equation 79 in Fig. 21, influence of operation costs and long-term treatment cost can be reduced. Accordingly, medical payments can be predicted more accurately.

In contrast, as admitted by the Examiner, Summerell fails to show the above-mentioned features of claim 1. Campell merely shows a computer-based system for predicting future health of an individual by quantitatively estimating the probability of acquiring the specified biological condition based on the distribution of the selected biomarkers. Campell does not show or suggest, either expressly or implicitly the above-mentioned features of claim 1.

Jagger merely shows Sullivan's method for calculating an individual's health expectancy, which is a number of remaining years at a particular age, that the individual can expect to live in a healthy state (third paragraph on page 4). Jagger, however, says nothing about a prediction amount of the future medical payment. Accordingly, Jagger does not show or suggest, either expressly or implicitly, the above-mentioned features of claim 1, namely, that a predicting amount of future medical payment is calculated by the summation of the average medical expenses a year per age multiplied by correction coefficients for the predicted duration of disease and/or disability that is difference between an average life expectancy and the predicted period of healthy life expectancy, the correction coefficients being set so as to decrease the average medical expenses a year per age as the recuperation period is prolonged.

Furthermore, contrary to the Examiner's assertion, Joao merely shows that the database includes various kinds of information used for diagnosis or claim transaction. Joao, however, does not show or suggest, either expressly or implicitly, the above-mentioned features of claim 1, namely, that a predicting amount of future medical payment is calculated by the summation of the average medical expenses a year per age multiplied by correction coefficients for the predicted duration of disease and/or disability that is difference between an average life expectancy and the predicted period of healthy life expectancy, the correction coefficients being set so as to decrease the average medical expenses a year per age as the recuperation period is prolonged.

Furthermore, the other secondary references of Iliff and Seare fail to provide any disclosure, teaching or suggestion that make up for the deficiencies in the combination of Summerell, Campell, Jagger and Joao.

In sum, there is no suggestion or motivation in all the prior art cited to combine these features explicitly or implicitly, or in the knowledge generally available to one of ordinary skill in the art at the time the invention was made to embody all the features of the invention as recited in claim 1. Accordingly, claim 1 is not obvious in view of all the prior art recited.

Claim 12

Claim 12 has the substantially same features as those of claim 1, at least with respect to preparing medical payment prediction knowledge data as basic data for predicting medical payment from a diversity of healthy life expectancy; and calculating a predicting amount of future medical payment of the each person who undergoes health screening based on the predicted period of healthy life expectancy of the each person and the medical payment prediction knowledge data, wherein a predicting amount of future medical payment is calculated by the summation of the average medical expenses a year per age multiplied by correction coefficients for the predicted duration of disease and/or disability that is difference between an average life expectancy and the predicted period of healthy life expectancy, the correction coefficients being set so as to decrease the average medical expenses a year per age as the recuperation period is prolonged. As such, the arguments set forth above are equally applicable here. Claim 1 being allowable, claim 12 must also be allowable.

Claims 2-6, 8-11, 13-17, 19-21, 23

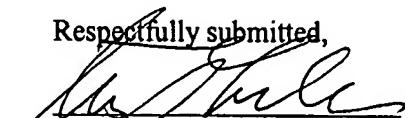
As to dependent claims 2-6, 8-11, 13-17, 19-21, and 23, the arguments set forth above with respect to independent claims 1 and 12 are equally applicable here. The corresponding base claims being allowable, claims 2-6, 8-11, 13-17, 19-21, and 23 must also be allowable.

Conclusion

In view of all the above, Applicants respectfully submit that certain clear and distinct differences as discussed exist between the present invention as now claimed and the prior art references upon which the rejections in the Office Action rely. These differences are more than sufficient that the present invention as now claimed would not have been anticipated nor rendered obvious given the prior art. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application as amended is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

Respectfully submitted,



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